



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/686,344

10/14/2003

W. Todd Daniell

190250-1600

7194

38823

7590

10/12/2006

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/
BELLSOUTH I.P. CORP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

EXAMINER

CARLETON, THUY T

ART UNIT

PAPER NUMBER

2196

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,344

Applicant(s)

DANIELL ET AL.

Examiner

Thuy Carleton

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/20/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claims 1-23 are pending in this application and have been examined.

Claim Objections

1. Claim 2 is objected to because of the following informalities: the phrase "the indication" spanning lines 2-3 of claim 2 points out two separate types of indications described in two separate places: in line 3 of claim 1 "an indication to save" and in line 2 of claim 2 "an indication to terminate". The examiner assumes the phrase "the indication" in lines 2-3 refers to "indication to save" in line 3 of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claim 17, the Applicant claims "a system" but fails to perform structural steps to support the system. Instead, the Applicant claims "logic" steps, which is non-structural steps as described by the "Microsoft Press – Computer Dictionary, Third Edition" as "In programming, the assertions, assumptions, and operations that define what a given

Art Unit: 2196

program does. Defining the logic of a program is often the first step in developing the program's source code".

As such, claims 18-23 are rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As claim 9, pages 53-54 of Applicant's specification provide guidance as to what Applicant considers to fall within the scope of the phrase "computer-readable medium" as used in currently pending claims 9-15. The pertinent portions of pg 53-54 are as follows:

In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a nonexhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (electronic), a read-only memory (ROM) (electronic), an erasable programmable read-only memory (EPROM or Flash memory) (electronic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical).

Art Unit: 2196

Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured via, for instance, optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.

Thus it is clear that while Applicant has not provided an explicit and deliberate definition limiting the phrase "computer-readable medium," Applicant has provided an explicit and deliberate definition of items Applicant intends to fall within the scope of "computer-readable medium." Within this list of items are types of media, which would have been recognized by one of ordinary skill at the time of the invention as storage media, propagation or transmission media, and printed matter. It is believed that the types of storage media listed by Applicant would have enabled the recited program logic, when stored thereon, to be read and executed by a computer and realize its functionality. It is not believed, however, that the recited propagation or transmission media would likewise enable the functionality to be realized. Absent recitation of some means for receiving and processing the program, propagation or transmission media are not believed to be, in and of themselves, capable of providing the program in a manner which enables it to be read and executed by a computer, with subsequent realization of its functionality to accomplish a practical application by causing the computer to perform operations with a useful, concrete and tangible result.

Certainly, Applicant's inclusion of a piece of paper with the program printed thereon within the scope of "computer-readable medium" indicates the claims are sufficiently broad to read on non-functional descriptive material, printed matter. Printed matter which fails to be functionally interrelated to its substrate has long been held to be non-statutory.

From MPEP 706.03(a):

For example, a mere arrangement of printed matter, though

Art Unit: 2196

seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

As such, claims 9-15 are not limited to embodiments which would enable execution of the program by a computer to realize its functionality and provide a practical application with a useful, concrete and tangible result. Note that any deletions from the specification may raise a question with respect to New Matter.

As to claim 17, a "system" is being recited; however, as disclosed by the specification sections are taught to be software, per se. A system with no structural and functional interrelationship between computer elements is computer software by itself.

As such, claims 18-23 are rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 7, 9-10, 14, 16-18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Michael Lehman (Wayback machine:

Art Unit: 2196

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>), hereinafter "Lehman"

As claim 1, Lehman teaches a method for saving a transcript of instant messaging (IM) chat sessions, the method comprising the steps of: receiving an indication to save an IM chat transcript of an IM chat session (pg 10 - fig 105); and saving an IM chat transcript in response to receiving the indication (pg 10 - fig 104).

As claim 9, Lehman inherently teaches a computer-readable medium comprising: computer-readable code adapted to instruct a programmable (pg 10, fig 105 - the dialog box instructing the user to save the chat history) device to receive an indication to save an IM chat transcript of an IM chat session (pg 10 - fig 105); and computer-readable code adapted to instruct a programmable device to save an IM chat transcript in response to receiving the indication (pg 10 - fig 104).

As claim 16, Lehman teaches a system for saving a transcript of instant messaging (IM) chat sessions, the system comprising: means for receiving an indication to save an IM chat transcript of an IM chat session (pg 10 - fig 105); and means for saving an IM chat transcript in response to receiving the indication (pg 10 - fig 104).

As claim 17, Lehman teaches a system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

Art Unit: 2196

receive logic configured to receive an indication to save an IM chat transcript of an IM chat session (pg 10 - fig 105) ;
and save logic configured to save an IM chat transcript in response to receiving the indication (pg 10 - fig 104).

As claim 2, 10 and 18, Lehman inherently teaches receiving an indication to terminate the IM chat session prior to receiving the indication to save (pg 10, Section Options, first paragraph - Lehman teaches prompting the user to save the history in response to an indication to close the chat window; wherein the indication to terminate is the close command for the window);
providing a prompt in response to receiving the indication to terminate the IM chat session (pg 10 - fig 105);
an indication to save the IM chat transcript; and an indication to not save the IM chat transcript (pg 10 - fig 105);
and wherein the step of receiving the indication to save the IM chat transcript is responsive to the step of providing the prompt (pg 10 - fig 105).

As claim 7, 14 and 22, Lehman further teaches saving the IM chat transcript as text file (pg 9-10, Section Chat History, fourth paragraph; fig 104).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2196

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5, 11, 12, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehman in view of Kusuda. (US Pub 2003/0088623), hereinafter "Kusuda"

As claim 3, 11 and 19, Lehman does not teach wherein the step of saving the IM chat transcript comprises the step of: saving the IM chat transcript as an IM chat window. However, Kusuda teaches saving the IM chat transcript as an IM chat window (fig 2; fig 3, label 412; fig 4, label 311, 320 and 314; fig 5; par [0057]-[0058] and [0115]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lehman by saving the IM chat transcript as an IM chat window as taught by Kusuda in order to save IM Chat session in Hypertext Markup Language (HMTL) is a benefit giving the user the ability to save the text and embedded images from an IM chat session for historical purposes and further after saving allow the chat session to be viewed in a freely available web browser.

As claim 4, Lehman further teaches wherein the IM chat window comprises a record of IM events, the IM events being selected from a group consisting of: a list of participants in the IM chat session (pg 4 - fig 101).

As claim 5, 12 and 20, Lehman further teaches converting the IM chat transcript to a text file (pg 9-10, Section Chat History, fourth paragraph; fig 104).

Art Unit: 2196

10. Claims 6, 8, 13, 15, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehman in view of Kusuda and further in view of Gusler et al. (US Pub 2003/0105815), hereinafter "Gusler"

As claim 6, 13 and 21, Lehman and Kusuda do not teach converting the IM chat transcript to an email message. However, Gusler teaches converting the IM chat transcript to an email message (par [0041]-[0042, converting the IM chat transcript to an email message is inherent by having the ability to provide the transcripts in a variety of different ways to including free text, encrypted text, and binary files readable by any other standard text processing software). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lehman and Kusuda by converting the IM chat transcript to an email message as taught by Gusler in order to communicate a copy of the transcript to a parent, guardian or other designated representative allowing them to examine the transcript to determine if inappropriate contacts are occurring.

As claim 8, 15 and 23, Lehman and Kusuda do not teach saving the IM chat transcript as an email message. However, Gusler teaches saving the IM chat transcript as an email message (par [0041], saving the IM chat transcript as an email message is inherently a step prior to sending an email message to a recipient). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lehman and Kusuda by saving the IM chat transcript as an email message as taught by Gusler in order to communicate a copy of the transcript to a parent, guardian

Art Unit: 2196

or other designated representative allowing them to examine the transcript to determine if inappropriate contacts are occurring.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rika Kusuda (US Pub 2003/0088623) – (Collaborative chat system)

Fellenstein et al. (US Patent 7,032,007) – Apparatus and method for monitoring instant messaging accounts.

Chien et al. (US Pub 2003/0090518) – Method for automatically forwarding and replying short message.

Paik et al. (US Pub 2002/0065887) – System and method of simultaneously executing pop e-mailing and chatting.

Baker (US Pub 2001/0048449) – Intelligence driven paging process for a chat room.

Martinez et al. (US Pub 2005/0060656) – Method and apparatus for viewpoint collaboration.

Ogasawara et al. (US Patent 6,014,136) – Data processing apparatus with communication function.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Carleton whose telephone number is 571-270-1258. The examiner can normally be reached on Monday-Friday.

Art Unit: 2196

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T.C.

Thuy Carleton


NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER